

REMARKS

This is in response to the Office Action mailed on February 19, 2003, in which claims 1-8, 10-11 and 19 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite, and under 35 U.S.C. § 103(a) as being unpatentable over EP-263 combined with the Applicants' admissions in the specification at page 2, lines 8-11 and 20-22.

Claims Rejections – 35 U.S.C. 112

Claims 1-8, 10-11 and 19 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite. The Examiner pointed out a number of informalities, specifically in claims 1, 2, 3, 6 and 8. With this Amendment, claims 1, 6 and 8 have been amended to correct the informalities noted by the Examiner.

Claim 2, as amended, recites that "the block copolymer comprises at least one polystyrene block." The Examiner suggested changing the phrase "polystyrene block" to "polystyrene block copolymer" to correct this claim. However, this change would inaccurately describe the composition of the block copolymer. As explained in the specification at page 7, lines 23-28, a block copolymer refers to a copolymer made of segmented blocks of polymers (such as polystyrene). Claim 2, as amended, simply recites that the block copolymer comprises at least one polystyrene block. Claim 3 recites that the block copolymer comprises 10% to 30% of polystyrene block. It is respectfully submitted that claims 2 and 3 correctly recite features of the present invention, and do not include informalities.

In view of the above-described amendments and discussion, the rejection of claims 1-8, 10-11 and 19 under 35 U.S.C. 112, second paragraph, should be withdrawn.

Claims Rejections – 35 U.S.C. 103

Claims 1-8, 10-11 and 19 were rejected under 35 U.S.C. 103(a) as being unpatentable over EP-263 (EP 0 443 263 B1) combined with the Applicants' admissions in the specification at page 2, lines 8-11 and 20-22. The Examiner contended that EP-263 discloses "a repositionable genus of articles that can comprise a label bearing (page 4, lines 1-2) low tack or tack-free elastomeric block copolymer adhesive that either reads upon or is at most a minor modification of applicants' preferred genus of thermoplastic elastomeric block copolymers." The Examiner further noted that the reference lacks a teaching of adhering the label to an optical recording medium (e.g., a compact disc). The Examiner turned to the specification at page 2, lines 8-11 and 20-22 to supply this deficiency in EP-263, noting that pressure sensitive adhesive labels for optical discs are known in the art, and concluded that it would have been obvious to employ the repositionable adhesive of EP-263 for an optical disc label in place of the pressure sensitive adhesives known in the art.

To establish a *prima facie* case of obviousness under 35 U.S.C. 103, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. M.P.E.P. 2143. It is improper to combine references where the references teach away from their combination. M.P.E.P. 2145, citing *In re Grasselli*, 218 U.S.P.Q. (BNA) 769, 779 (Fed. Cir. 1983).

There is no teaching or suggestion in the references of record to employ a non pressure-sensitive adhesive (having a storage modulus at room temperature greater than 3×10^5 Pascals) of the type disclosed in EP-263 in place of the pressure sensitive adhesives typically used for optical recording disk labels. As explained in more detail below, EP-263 teaches that its adhesive, when employed with a level of adhesion as claimed, is useful only for adhesion to another adhesive, which would teach one skilled in the art against using the EP-263 adhesive at the claimed level of adhesion to adhere a label to an optical recording disk.

EP-263 discloses an adhesive for use in products such as POST-IT® Note pads. POST-IT® Note pads bear a stripe of pressure-sensitive adhesive that is sufficiently tacky to adhere to paper and other substrates but does not show a build-up of adhesion (*see* EP-263, page 2, lines 6-8). An accepted description of a pressure-sensitive adhesive is that the adhesive has a storage modulus at room temperature of less than 3×10^5 Pascals. This is known as the

Dahlquist criterion (*see* specification, page 7, lines 6-14). Thus, typical adhesives that have a level of adhesion suitable for use on a POST-IT® Note pad have a storage modulus of less than 3×10^5 Pascals.

In describing its adhesive, EP-263 notes that "an adhesive which has a 90 degree Peel Value of from 2 to 8 N/25mm should be useful for making note pads of repositionable sheets like POST-IT® note pads, because such adhesive-bearing sheets should adhere well to paper and other substrates while being removable without picking fibers, even after prolonged periods of time." EP-263, page 4, lines 49-52. Since adhesive with this level of adhesion is useful for POST-IT® note pads (according to EP-263), it would not satisfy the requirements of claim 1, which recites a layer of adhesive that is non-pressure sensitive and that has a storage modulus at room temperature of greater than 3×10^5 Pascals.

In the next sentence, EP-263 states that "when the 90 degree Peel Value is from 0 to 2 N/25mm, the adhesive would be most useful in the above-described adhesive-to-adhesive closure as these are the least likely to adhere to ordinary packaging materials or to non-adhesive surfaces...." EP-263, page 4, lines 52-55. This low level of adhesion may satisfy the adhesion requirements of claim 1 (non-pressure sensitive, storage modulus greater than 3×10^5 Pascals). However, the teachings of EP-263 with respect to this level of adhesion are that the only use for such an adhesive is adhesive-to-adhesive closure, since this type of adhesive is unlikely to adhere to non-adhesive surfaces (such as the claimed optical recording medium, for example). One skilled in the art would not find any motivation to replace the pressure sensitive adhesive commonly used for optical recording medium labels with an adhesive as disclosed by EP-263 which is taught to be unlikely to adhere to non-adhesive surfaces. EP-263 teaches away from the combination of its low-level (non-pressure sensitive) adhesive with an optical recording medium label, and as such renders the combination of EP-263 and the admitted prior art improper.

Claim 1 specifically recites an article that employs a layer of non-pressure sensitive adhesive, having a storage modulus of greater than 3×10^5 Pascals, adhered to an optical recording medium. One skilled in the art surely would not have replaced a pressure sensitive adhesive of an optical recording medium label with an adhesive that is taught (by EP-263) to lack adhesion to non-adhesive surfaces. Accordingly, the combination of EP-263 and the admitted prior art to yield the invention recited in claim 1 is improper, and the rejection of claim 1 under 35 U.S.C. 103 should be withdrawn.

Claims 2-8, 10, 11 and 19 depend from amended independent claim 1, and are allowable therewith. In addition, it is respectfully submitted that the combinations of features

recited in claims 2-8, 11 and 19 are patentable on their own merits, although this does not need to be specifically addressed herein since any claim depending from a patentable independent claim is also patentable. See M.P.E.P. 2143.03, citing In re Fine, 5 U.S.P.Q.2d (BNA) 1596 (Fed. Cir. 1988).

Other Amendments to Claims

With this Amendment, claims 4, 5, 10 and 11 have also been amended to replace abbreviations with more clear notations. These amendments do not affect the scope of the claims.

New Claims

With this Amendment, new claims 20-23 have been added to further recite features of the present invention. Consideration and allowance of claims 20-23 is respectfully requested.

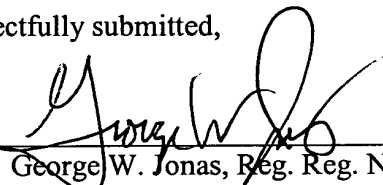
CONCLUSION

In view of the foregoing, all pending claims 1-8, 10, 11 and 19-23 are in condition for allowance. A notice to that effect is respectfully requested.

Respectfully submitted,

Date: 7/19/03

By


George W. Jonas, Reg. Reg. No. 46,811
Office of Intellectual Property Counsel
3M Innovative Properties Company
P.O. Box 33427
St. Paul, MN 55133-3427
Telephone: (651) 736-6933
Fax: (651) 736-3833

GWJ:AMK

First Named Inventor: Jacob J. Liu

Application No.: 09/849,147

APPENDIX:

MARKED UP VERSION OF SPECIFICATION AND CLAIM AMENDMENTS

1. (Twice Amended) An article comprising:

[(a)] a backing having two major surfaces,

[(b)] a layer of repositionable non-pressure sensitive adhesive comprising a thermoplastic block copolymer elastomer coated onto at least one major surface of the backing, wherein the adhesive has a storage modulus at room temperature greater than 3×10^5 Pascals, and[;]

[(c)] an optical recording medium having a first major surface and a second major surface opposite the first major surface, the first major surface [disposed against] adhered to the layer of repositionable non-pressure sensitive adhesive.

2. (Twice Amended) The article according to claim 1 wherein the block copolymer comprises at least one polystyrene block.

4. (Twice Amended) The article according to claim 1 wherein the adhesion of the repositionable non-pressure sensitive adhesive is greater than 3 [oz/inch] ounces per inch on the first major surface of the optical recording medium and is less than 3 [oz/inch] ounces per inch on skin and paper.

5. (Twice Amended) The article according to claim 4 wherein the adhesion to the first major surface is in the range 5 - 40 [ounce/inch] ounces per inch.

6. (Twice Amended) The article according to claim 5 wherein material forming the first major surface of the optical recording medium is selected from the group consisting of[:] polycarbonate, polyvinyl chloride, polyester, and glass.

8. (Twice Amended) The article according to claim 1 wherein the backing is selected from the group consisting of[:] polyester film, polyolefin film, paper, coated paper, metallized film, foil, non-wovens and cardstock.

10. (Twice Amended) The article according to claim 1 wherein the adhesive has an adhesion range of 3 to 40 [oz/inch] ounces per inch when adhered to the first major surface of the optical recording medium and an adhesion of less than 8 [oz/inch] ounces per inch when adhered to standard white paper having a standard weight of 20/50 [lbs] pounds.

11. (Twice Amended) The article according to claim 1 wherein the adhesion range on the first major surface is about 5 to about 10 [oz/inch] ounces per inch and the adhesion range on paper and skin is less than about 1 [oz/inch] ounce per inch.